REMARKS/ARGUMENTS

Favorable consideration of this application is respectfully requested.

Claims 1, 4, 6, 7, 11-15, and 18-20 are pending in this application. Claims 2, 3, 5, 8-10, 16, and 17 have been previously canceled without prejudice or disclaimer.

The outstanding Official Action presents a rejection of Claims 7 and 11 under the first paragraph of 35 U.S.C. §112, a rejection of Claims 1, 4, 6, 7, 11 and 19 under 35 U.S.C. §103(a) as being unpatentable over Belu (U.S. Published Patent Application No. 2002/0033762) in view of Videcrantz et al. (U.S. Patent No. 6,275,588, Videcrantz), and a rejection of Claims 12-15, 18, and 20 under 35 U.S.C. §103(a) as being unpatentable over Belu in view of Videcrantz and Gabon (U.S. Patent No. 5,943,421).

Turning first to the rejection of Claims 7 and 11 under the first paragraph of 35 U.S.C. §112, this rejection appears to be based on the language "about locations of individual ones of said plurality of individual programs" and the lack of this exact wording in the specification as filed. However, page 10, lines 6-11, of the specification indicate that:

> Since the CPU 1-1 can also find out the number of programs contained in the data 21 and their respective size based on the restored information data 22 and 23, it calculates the head address of each program from such information, creates a program management table 51 about the correspondence between each program and its head address and size, and stores the program management table 51 in the RAM 3. (Emphasis added.)

What is clear here and from the example shown by FIG. 3 that is discussed at lines 12-17 of this page, each individual program (shown as A-D in Fig. 3) is associated with an address (shown as 01-04 in Fig. 3) and size (shown as 01-04 in Fig. 3). To whatever extent that the questioned claim language is a paraphrasing of the above-noted page 10, lines 6-17 disclosure, such paraphrasing or rewording is permitted as long as the same meaning remains intact. *See In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973) and note MPEP § 2163.07 under the heading "**I. REPHRASING**" at page 2100-185. Also note *In re*

Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) establishing that "the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure [Fig. 3 and page 10, lines 6-17] a description of the invention defined by the claims," and *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CPA 1972) (stating that "the description need not be in *ipsis verbis* [in the same words] to be sufficient").

Accordingly, withdrawal of the rejection of Claims 7 and 11 under the first paragraph of 35 U.S.C. §112 is respectfully requested.

The rejection of Claims 1, 4, 6, 7, 11 and 19 under 35 U.S.C. §103(a) as being unpatentable over <u>Belu</u> in view of <u>Videcrantz</u> is traversed because even if the artisan had some reasonable basis to combine these references they would not teach all the limitations of these claims.

First in this regard, independent Claim 1 is a "means-plus-function" claim. *Gechter v. Davidson,* 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) requires the PTO to construe the scope of the structures disclosed in the specification for the claimed "means," to explain how the "means" as disclosed in the specification are structurally equivalent to the relied upon elements embodied in the references to define the exact function of each claimed "means," as well as to explain how the relied upon reference elements are disclosed to perform the identical functions.

For example, the outstanding Action fails to follow the required analysis as it fails to properly construe the independent Claim 1 "first generation means" of its function of "generating and outputting first auxiliary data including a total number of individual programs combined and compressed by the compression means and a size of each individual program combined and compressed by the compression means," for example. Independent Claim 1 does not simply recite "having a file header that contains auxiliary data such as the

names, sizes, compressed sizes, etc." as urged at page 3, lines 14-16, of the outstanding

Action as to the teachings of paragraphs 40-42 of Belu. A file header does not generate or

output any thing by itself and is not the "equivalent" of the CPU disclosed in the specification

(at page 11, lines 18-24) to count "the number of programs" and to calculate "the size of each

of the programs."

Also, and as admitted in the outstanding Action, neither Belu nor Videcrantz teach or

suggest the claimed function of "generating and outputting first auxiliary data including a

total number of individual programs combined and compressed by the compression means."

To overcome this deficiency, the outstanding Action offers the conclusion that counting the

number of files making up the compressed file was obvious without any substantial evidence

of such counting being provided.

This conclusion is not supported by any evidence and ignores that Claim 1 does not

simply recite the indication of the total number of individual programs combined and

compressed by the compression means in some vague and undefined manner. Instead, Claim

1 requires that the "total number of individual programs combined and compressed by the

compression means" is to be part of the auxiliary data generated and output by the "first

generation means" along with the "size of each individual program combined and

compressed by the compression means."

Besides the fact that the rationale as to the obviousness of counting the number of

programs fails to consider that the "first generation means" must perform this function along

with determining the "size of each individual program," the outstanding Action errs in failing

to supply any evidence in support of the conclusion of obviousness of this feature. The PTO

reviewing court has noted more than once that the PTO falls under the Administrative

Procedure Act that requires the PTO to provide "substantial evidence," not mere

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unsubstantiated opinions and conclusions. *See In re Lee*, 217 F.3d 1365, 61 USPQ2d 1430,

1433-34 (Fed. Cir. 2002) as follows:

> Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies. *Dickinson v. Zurko,* 527 U.S. 150, 50 USPQ2d 1930 (1999). Thus on appeal we review a PTO Board's findings and conclusions in accordance with the following criteria:
> 5 U.S.C. §706(2) The reviewing court shall—
> (2) hold unlawful and set aside agency actions, findings, and conclusions found to be—
> (A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;
> * * * *
> (E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute;

> For judicial review to be meaningfully achieved within these strictures, the agency tribunal must present a full and reasoned explanation of its decision. The agency tribunal must set forth its findings and the grounds thereof, as supported by the agency record, and explain its application of the law to the found facts. The Court has often explained:

> > The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of "reasoned decision making." Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

The relied upon teachings of Videcrantz do nothing to correct the above noted

deficiencies in Belu. Accordingly, the rejection of independent Claim 1 as being unpatenable

over Belu in view of Videcrantz under 35 U.S.C. §103(a) is clearly improper and should be

withdrawn.

With further regard to independent method Claim 6, this independent claim recites,

for example, a step of "generating first auxiliary data including a total number of individual

programs that have been combined and compressed and a size of each individual combined

and compressed program." Just as the relied upon Belu file header is not a means for

generating it also is not a method step of generating.

Also, Claim 6 is similar to Claim 1 as it requires the generating of auxiliary data that must indicate both the "total number of individual programs that have been combined and compressed and a size of each individual combined and compressed program." As noted above, mere undocumented conclusions as to counting files in the compressed archive are insufficient to demonstrate obviousness under 35 U.S.C. § 103.

Once again, the teachings of <u>Videcrantz</u> do nothing to correct the above noted deficiencies in <u>Belu</u>. Accordingly, the rejection of independent Claim 6 as being unpatenable over <u>Belu</u> in view of <u>Videcrantz</u> under 35 U.S.C. §103(a) is clearly improper and should be withdrawn.

Turning to independent Claim 7, this is again a "means-plus-function" claim that has not been properly construed as noted above relative to the *Gechter v. Davidson* decision as no attempt has been made to construe the scope of the structures disclosed in the specification for the claimed "means," to explain how the "means" as disclosed in the specification are structurally equivalent to the relied upon <u>Belu</u> disclosed header portion being decrypted and decompressed to be "readily available to be recreated" as merely speculated at the bottom of page 4 of the outstanding Action.

Not only does the rationale offered as to the use of assumptions and speculation in place of evidence violate the precedent established by the above noted *Lee* decision, it violates *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) ("The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.").

Moreover, Claim 7 requires far more than just decryption with decompression noted in the outstanding Action. In this respect, Claim 7 requires the "creation means <u>operatively</u> <u>connected to the decryption means</u> for receiving the decrypted first auxiliary data and for

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creating <u>a management table about locations of individual ones of said plurality of individual</u> <u>programs based on said decrypted first auxiliary data</u>" and it requires a "memory means <u>operatively connected to receive the decompressed and combined individual programs from</u> <u>the decompression means and to receive the management table from the creation means</u> and for storing the decompressed and combined individual programs and said management table" (emphasis added). Rather than address the express claim limitations and required connections, the bottom of page 4 of the outstanding Action relies on broad assertions as to each file header being readily available to be recreated into some kind of list of file headers in a manner not explained in terms of the teachings of any prior art reference.

For example, the outstanding Action fails to present any explanation or evidence as to why the artisan would want to use file headers of <u>Belu</u> to recreate a separate list as the information in the file headers is available when they are decrypted and decompressed. Also missing is the evidence and rationale to form this hypothetical list as the claimed "management table about locations of individual ones of said plurality of individual programs." Also, no evidence or rationale is supplied to show that obtaining a recreated list of file headers would not be done, if done at all, by a simple printing of each individual file header. Such separate printed file headers would not be capable of being stored as an "output into RAM, a hard drive or cache" as speculated at the bottom of page 4 of the outstanding Action.

It is further well established that the fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *See In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the

extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted, emphasis added). Thus, even if a list were prepared, there is nothing that is inherent as to the Claim 7 "memory means" that must also "receive the decompressed and combined individual programs from the decompression means" along with receiving "the management table from the creation means" to then store "he decompressed and combined individual programs and said management table" as specified.

Therefore, as the compression-encryption/decryption-decompression teachings of Videcrantz do nothing to correct the above noted deficiencies in Belu, the rejection of independent Claim 7 as being unpatenable over Belu in view of Videcrantz under 35 U.S.C. §103(a) is clearly improper and should be withdrawn.

Independent Claim 11 is similar to independent Claim 7 in presenting the functions of independent Claim 7 in method step form. The reasons why the rejection applied to Claim 11 is improperly based upon assumptions lacking evidence in support thereof and an improper use of inherency are, thus, the same as noted above as to independent Claim 7.

Once again, as the teachings of Videcrantz do nothing to correct the above noted deficiencies in Belu, the rejection of independent Claim 11 as being unpatenable over Belu in view of Videcrantz under 35 U.S.C. §103(a) is clearly improper and should be withdrawn.

Further, as Claim 4 depends directly on independent Claim 1 and Claim 19 depends directly on Claim 6, the rejection applied thereto as being unpatentable over Belu in view of Videcrantz under 35 U.S.C. §103(a) is clearly improper and should be withdrawn for the reasons noted above as to each respective parent independent claim. In addition, each of

dependent Claims 4 and 19 add further features that are also not taught or suggested by <u>Belu</u> and/or <u>Videcrantz</u> considered alone or together in any proper combination. Accordingly, the rejection applied thereto as being unpatentable over <u>Belu</u> in view of <u>Videcrantz</u> under 35 U.S.C. §103(a) is clearly improper and should be withdrawn for this reason as well.

The rejection of independent Claim 12 under 35 U.S.C. §103(a) as being unpatentable over <u>Belu</u> in view of <u>Videcrantz</u> and <u>Gabon</u> is traversed for essentially the reasons noted above as to independent Claim 1 and dependent Claim 4. In this regard, independent Claim 12 is a "means-plus-function" claim that essentially incorporates the limitations of independent Claim 1 and dependent Claim 4 along with some of the limitations of independent Claim 7. None of these "means" or their corresponding functions has been properly construed as noted above relative to the *Gechter v. Davidson* decision and the above-noted lack of evidence as to Claim 1 limitations is again relevant.

The rejection of independent Claim 18 under 35 U.S.C. §103(a) as being unpatentable over <u>Belu</u> in view of <u>Videcrantz</u> and <u>Gabon</u> is traversed for essentially the reasons noted above as to independent Claim 6 and dependent Claim 19. In this regard, independent Claim 18 is a method claim that essentially incorporates the limitations of independent Claim 6 and dependent Claim 19 along with some of the limitations of independent Claim 11. Accordingly, as the teachings of <u>Grabon</u> do nothing to correct the above noted deficiencies in <u>Belu</u> and <u>Videcrantz</u> set forth as to these incorporated limitations, the rejection of independent Claim 18 as being unpatenable over <u>Belu</u> in view of <u>Videcrantz</u> in further view of <u>Grabon</u> under 35 U.S.C. §103(a) is clearly improper and should be withdrawn.
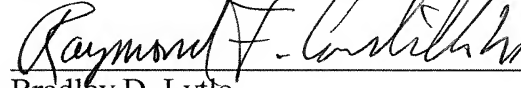
As Claims 13-15 ultimately depend on independent Claim 12 and Claim 20 depends directly on independent Claim 18, the rejection applied thereto as being unpatentable over <u>Belu</u> in view of <u>Videcrantz</u> and <u>Grabon</u> under 35 U.S.C. §103(a) is clearly improper and should be withdrawn for the reasons noted above as to each respective parent independent

claim. In addition, each of dependent Claims 13-15 and 20 adds further features that are also not taught or suggested by Belu and/or Videcrantz and/or Grabon considered alone or together in any proper combination. Accordingly, the rejection applied thereto as being unpatentable over Belu in view of Videcrantz and Grabon under 35 U.S.C. §103(a) is clearly improper and should be withdrawn for this reason as well.

As no further issues are believed to remain outstanding in the present application, it is believed that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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